

REMARKS

Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner. Claims 1-7, 24-28, and 44-58 were pending at the time of the outstanding Office Action. All pending claims stand rejected. The Office is respectfully requested to reconsider the rejections present in the outstanding Office Action.

On December 9, 2009, Applicants' representatives conducted a telephone interview with the Examiner. The claims and the references of record were discussed; however, no agreement was reached.

It should be noted that Applicants are not conceding in this application the claims amended and/or cancelled herein are not patentable over the art cited by the Examiner, as the present claim amendments and/or cancellations are only for facilitating expeditious prosecution of this application. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications. Applicants specifically state no amendment to or cancellation of any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended or cancelled claim.

Rejections under 35 U.S.C. § 112

Claims 44-47 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description of the invention requirement. The Examiner asserts

that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention. Applicants respectfully disagree and request reconsideration and withdrawal of these rejections.

The Examiner specifically asserts that "...transmitting the unique code to the at least one second user via a mode outside of the multi-user gaming environment; *receiving the unique code from the at least one second user...*" should rather read "receiving the unique code *from the first user*". *Office Action*, p. 2-3 (emphasis in original). Applicants respectfully disagree and direct the Examiner's attention to the specification at page 16, paragraph [0041], wherein it states:

The multi-user interactive communication environment may additionally provide a mechanism for exchanging typed (i.e. free form) messages. For example, as illustrated in Fig. 10, if user X prefers to initiate free form interaction with another user Y, then user X may be required to first get a unique identification code from the game server 20. The unique identification code, i.e. a "secret," may be retrieved by selecting an appropriate icon...*In response to this request, a randomly generated sequence of symbols...may be provided to the requesting user [X]. User X, upon receiving this unique "secret code," can subsequently send it to user Y via a mode outside of the communication environment (e.g. through electronic mail...).* *User Y could then initiate real-time, free form interaction directly with user X, if user X is present in the environment, by inputting this "secret code" in the environment and then getting it authenticated by the environment.*

Specification at [0041] (emphasis added) (citations to paragraph numbers herein correspond to the paragraph numbers of the original specification). Applicants also respectfully submit that adequate written description for claim 44 can also be found by looking at Fig. 10 and reading the numbered steps. Applicants thus respectfully submit that the claims (44-47) are fully compliant with the written description of the invention

requirement and the rejections under § 112 should be reconsidered and withdrawn. Applicants also note that these claims have not been rejected under 35 U.S.C. §§ 102, 103 and therefore Applicants cannot submit remarks regarding these claims against the references of record at this time.

Rejections under 35 U.S.C. § 103

Claims 1-7, 24-28 and 44-58 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Danieli et al. (U.S. Patent No. 7,240,093, hereinafter “Danieli”) in view of Machiro (U.S. Patent Pub. No. 2002/0062348, hereinafter “Machiro”) and Harvey et al. (U.S. Patent Pub. No. 2002/0059379, hereinafter “Harvey”). Applicants respectfully disagree and request reconsideration and withdrawal of these rejections.

Applicants respectfully submit that the references fail to teach or suggest all the claim limitations. The Examiner is kindly reminded that “[w]hen determining whether a claim is obvious, an examiner must make a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art. Thus, obviousness requires a suggestion of all limitations in a claim. Moreover, as the Supreme Court recently stated, *there must be some articulated reasoning* with some rational underpinning to support the legal conclusion of obviousness.” *Ex parte H. Garrett Wada et al.*, p. 7, Appeal No. 2007-3733 (BPAI January 14, 2008) (internal quotation marks and citations omitted) (emphasis in original) (reversing Examiner’s obviousness rejection).

As an initial matter, Applicants respectfully submit that there is no “...*articulated reasoning* with some rational underpinning to support the legal conclusion of

obviousness”, *Ex parte Wada* at 7, whatsoever with respect to claims 44-47 presented in the Office Action. Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness for these claims, as previously presented.

Moreover, Applicants respectfully submit that the references fail to teach or suggest limitations of the previously presented claims, including at least “...during communication between the first user and at least one other user via an exchange of words from a menu of predetermined words between the first user and the at least one other user...” Claim 1 (emphasis added). Applicants respectfully submit that the cited portions of Danieli (*Office Action*, p. 3) fail to teach or suggest this limitation (or the like found in other independent claims), even under the Office’s broadest reasonable interpretation standard. Applicants respectfully submit that Danieli does not teach or suggest that the “words from a menu of predetermined words” are exchanged between users. Claim 1.

Nonetheless, Applicants have amended certain claims herein solely for the purpose of facilitating expeditious prosecution of this application. For Example, claim 1 now recites, *inter alia*:

...limiting communication between users in a multi-user communication environment to a menu-driven system of pre-prepared chat messages until an authenticated relationship is established between the users; providing a unique code generated by the multi-user communication environment to a first user in the multi-user communication environment; and enabling free form communication between the first user and a second user in response to establishing the authenticated relationship between the first user and the second user; wherein the authenticated relationship comprises an association of the unique code with the first user and the second user; the

authenticated relationship is established between the first user and the second user in response to receipt by the multi-user communication environment of the unique code from the second user; and the unique code is not transmissible between the first user and the second user via the multi-user communication environment.

Claim 1 (emphasis added). The remaining independent claims have been similarly amended. Support for these amendments can be found throughout the specification, particularly at [0028], [0041] and Fig. 10. Applicants respectfully submit that the references of record, even when considered in combination, fail to teach or suggest the above-quoted limitations. Accordingly, Applicants respectfully submit that the claims are clearly distinguishable from the art of record and request reconsideration and withdrawal of these rejections.

It should also be noted that certain dependent claims have been amended herein. Applicants additionally direct the Examiner's attention to claims 5 and 27, which have been amended to recite, *inter alia*, "and further wherein the pre-prepared chat messages correspond to one or more gaming functions". Support for these amendments can be found throughout the specification, particularly at [0030].

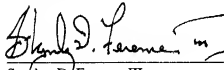
Newly Presented Claims

Applicants have presented herein new claims 59-64. Support for these claims can be found throughout the specification, particularly at paragraphs [0028]-[0032], [0039]-[0041]. Applicants respectfully submit that these claims are clearly distinguishable from the art of record and the state of the art and are thus in condition for allowance.

Conclusion

In view of the foregoing, it is respectfully submitted that claims are in condition for allowance. Notice to the effect is hereby earnestly solicited. **If the claims are not in condition for immediate allowance, the Applicants respectfully request the courtesy of a telephone interview prior to the issuance of any further Action.**

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Stanley D. Ference III", is written over a horizontal line.

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